

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

14485RRUS01U

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on December 16, 2009 (in accordance with 37 C.F.R. §1.6(a)(4))

Signature /Sherry Wolf McWhinnie/

Typed or printed name Sherry Wolf McWhinnie

Application Number

09/981,268

Filed

October 17, 2001

First Named Inventor

Peter W. Wenzel

Art Unit

2617

Examiner

Willie J. Daniel, Jr.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/Kevin L. Smith/

Signature

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Kevin L. Smith

Typed or printed name

☒

attorney or agent of record.

Registration number 38620

972-7728836

Telephone number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

December 16, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.5. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Wenzel et al.

Serial No. 09/981,268

Filed: October 17, 2001

For: Home Agent Redundancy in a Cellular System

Group No.: 2617

Conf. No.: 6371

Examiner: Willie J. Daniel, Jr.

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**ARGUMENT ACCOMPANYING THE
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

Submitted with the Request for Pre-Appeal Brief Request for Review are these arguments and remarks, with a notice of appeal accompanied by the appropriate fee, and before the filing of an appeal brief.

A final office action had been mailed September 16, 2009, in which a response was filed, within the two month advisory period, on November 13, 2009. An advisory action was mailed, advising in sum that Claims 1-7 and 10-21 of the instant application stand rejected as being unpatentable as obvious under 35 USC § 103(a).

In general, the rejections were based upon the hypothetical combination of U.S. Patent Application Publication No. 2002/0067704, to Ton ("Ton") in view of Perkins, IP MOBILITY SUPPORT (October 1996) ("Perkins I"). With respect to Applicant's Independent Claim 10, the Final Office Action further adds U.S. Patent Application Publication No. 2002/0078238, to Troxel ("Troxel"), to the hypothetical combination of Ton and Perkins I. Also, several secondary references had been cited against Applicant's dependent claims. (*see* Response to Final Office Action, filed November 13, 2009).

A. Applicant's claim language is directed towards overcoming initial registration/attachment failure

Applicant's specification points out that "[b]ecause each subscriber unit has a corresponding home agent, during initial registration operations, the subscriber unit must register with its assigned home agent. . . . However, because the IP address of its assigned home agent is hard-coded in its memory, if the assigned home agent is not operational (not an uncommon event) when the subscriber unit attempts registration, a failure in registration results [in which] the subscriber unit is [precluded] from receiving IP communication service from its cellular system provider." (Specification at page 2, *ll.* 13-27, through page 3, *ll.* 1-2).

For discussion purposes, Applicant's Independent Claim 1 recites, *inter alia*, a "method for registering a subscriber unit upon initial use within a cellular system, the method comprising: initially programming addresses for a plurality of home agents in the subscriber unit *prior to an initial registration attempt with a primary home agent*, . . . attempting the initial registration attempt with the primary home agent; when the subscriber unit fails to achieve registration via the initial registration attempt with the primary home agent of the plurality of home agents, selecting a secondary home agent from the plurality of secondary home agents; and attempting registration with the selected secondary home agent."

The cited references do not teach or suggest initial programming or storage of a plurality of home agents in a subscriber unit prior to an initial registration attempt.

B. Advisory Action cites *In re Keller* as Applicant improperly attacks references

The Office Action submits that "[o]ne cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)." (Advisory Action). Applicant, however, respectfully submits that the cited references do not suggest that which is recited in its claims. *In re Keller* supports this proposition.

In *Keller*, the Court submitted that "the test is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the

claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d at 425 (citations omitted).

Applicant respectfully submits that the teachings of Ton in view of Perkins I (or Troxel) would not have suggested the pre-initial registration circumstances as set out in Applicant’s claims. The test is that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1356 (Fed. Cir. 1998) (citations omitted); *In re Translogic Technology, Inc.*, 504 F.3d 1249 (Fed Cir. 2007) (post-KSR opinion citing *In re Rouffet* with approval).

C. Applicant respectfully submits that a *prima facie* showing of obviousness has not been made with respect to Applicant’s amended claims

Applicant’s Independent Claims 1 and 15 were rejected under the hypothetical combination of Ton in view of Perkins I. Applicant’s Independent Claim 10 was rejected under the hypothetical combination of Ton in view of Perkins I, and further in view of Troxel.

Applicant respectfully submits that the cited rejections generally mirror those of an earlier Final Office Action having a mailed date of June 5, 2006, without consideration of the amended language of the claims. Also repeated is the “same field of endeavor” without complying with the findings required under the MPEP. *See* MPEP 2143 at page 2100-136 (Rev. 6, Sept. 2007); (*see, e.g.*, Final Office Action at pages 5, 9, 11).

I. Ton recites post-attachment redundancy of the Mobile Node with a Foreign Agent, not initially programming addresses for a plurality of home agents in the subscriber unit prior to an initial registration attempt with a primary home agent as set out in Applicant’s claims

Referring to Ton, the Final Office Action submits that “where the subscriber unit can receive an advertisement to be aware of another home agent in addition to the primary home agent that is pre-assigned to the subscriber unit as evidenced by the fact that one of ordinary skill in the art would clearly recognize (*see* pg. 3, [0036, lines 9-12; 0039, lines 3-41]” (Final Office Action at p. 3). An Advertisement under Ton is an “advertisement message constructed by

attaching a special Extension to a router advertisement . . . message.” (Perkins I at p. 5; *see* Ton ¶ 0038). This is post-registration activity.

The portion of Ton referred to in the Final Office Action recites that “[post-registration,] the network will provide a number of Home Agents thorough which the Mobile Node may register, although the Mobile Node will be statically configured [by the network operator] to register with a given Home Agent.” (Ton ¶¶ 0023, 0028). That is, the network provides additional home agents post-attachment.

Applicant respectfully submits that Ton teaches post-attachment redundancy, not pre-initial. After the MN is registered, and the primary Home Agent finds a less busy Home Agent, then it provides the MN with “an additional Mobile IP extension is added to the registration reply message.”

2. *the home agent discovery of Perkins I does not recite initially programming addresses for a plurality of home agents in a subscriber unit prior to an initial registration attempt, and subsequent access based upon failed initial registration*

The Final Office Action submits that “Perkins clearly discloses having the feature wherein the plurality of addresses for the home agents stored in the subscriber unit is programmed by a service provider prior to delivering the subscriber unit to its subscriber (see pgs. 34-35, section 3.6), where a mobile node is configured with IP addresses.” (Final Office Action at page 6). Applicant’s claims, however, refer to initial registration.

Applicant respectfully submits that the foreign sister case to the instant application is distinguishable and overcomes Perkins I.

Also, Perkins I recites that its “home agent sends datagrams destined for the mobile node thorough a tunnel to the care of address. After arriving at the end of the tunnel, each datagram is then delivered to the mobile node.” (Perkins I at p. 1).

Perkins I relates to the IP version 4 protocol, which assumes that a node’s IP address uniquely identifies the node’s point of attachment to the Internet. (Perkins I at p. 2). In contrast, Applicant’s claims recite registering a subscriber unit upon initial use within a cellular system.

Further, The referenced language of Perkins refers to an address, not a plurality of addresses for a primary home agent and a plurality of secondary home agents.

3. Troxel added to Ton and Perkins I as in the “same field of endeavor,” although the Troxel reference does not refer to attachment or redundancy

Claims 2 and 3 depend directly or indirectly from Independent Claim 1. Claims 16 and 17 depend directly or indirectly from Independent Claim 15. Because the hypothetical combination of Ton in view of Perkins I, does not substantiate a *prima facie* case of obviousness as to Claims 1 and 15, Applicant respectfully submits that a *prima facie* showing of obviousness is unsubstantiated by the addition of Troxel as to claims 2, 3, 10, 11, 16, and 17.

The Final Office Action recites that “the examiner maintains that the feature rank ordering the plurality of home agents was well know in the art, as taught by Troxel. In the same field of endeavor, Troxel discloses the feature rank ordering the plurality of home agents (see pg. 4, [0051])” (Final Office Action at p. 10).

Under Troxel, data communication can be tunneled through other network components based on remote bindings. (*see* Troxel ¶¶ 0038, 0048). That is, Troxel relates to routing, not initial registration/attachment of a mobile node.

Applicant respectfully submits that there is no suggestion or motivation for the hypothetical combination of post-attachment devices of Ton and Perkins that would arrive at Applicant’s claimed invention. and further in view of tunneling based upon foreign agent (“FA”) ranking device of Troxel, to achieve Applicant’s invention as recited in its claims, much less teach or suggest all of Applicant’s claim limitations.

Respectfully submitted,

Date: December 16, 2009

/Kevin L. Smith/

Kevin L. Smith, Reg. No. 38,620

Garlick Harrison & Markison

P.O. Box 670007

Dallas, TX 75367

(972) 772-8836/office

(972) 772-5033/facsimile